

REMARKS

Applicant submits this Amendment in response to the Office Action dated September 18, 2008. Reconsideration of the subject application as amended herein is respectfully requested.

The Examiner has taken the position that the device described in the prior art Owens reference teaches "all the material limitations" of claims 1, 2, 8, 11 and 18-20, and therefore anticipates those claims under 35 U.S.C. § 102, and further that the Owens reference renders the remaining elected claims, that is, claims 3, 9, 10, 12-17 and 22, obvious under 35 U.S.C. §103. The Examiner contends that the device of Owens, even though meant for a different use than applicant's invention, has a structure that is nevertheless *capable* of performing the use intended by applicant, even though this would involve not only the melting and vaporization of the solid material which Owens uses as a non-sacrificial catalyst (and without subsequent condensation and re-solidification thereof), but also the release of its vapors from the container. The Examiner insists that "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art;" in other words, the

rejected claims do not define any *structural* (as opposed to functional) differences between the claimed invention and the prior art Owens reference.

Owens discloses a container, for use in an internal combustion engine, that holds a metallic substance in the form of pellets; the fuel is directed to flow through the container prior to combustion, so that the fuel contacts the pellets, and the metallic substance thereafter acts as a catalyst in the combustion of the fuel, all so as to reduce harmful emissions. It is clear that the catalytic metallic pellets themselves are not “used up” or consumed, that is, they are neither melted nor vaporized, during this process, and that in normal use they are never released from the container, in any form. Owens explicitly states that his container defines a “flow path” (column 2, line 16) for the fuel, so that the fuel can be treated by contacting the metallic substance (column 2, lines 30-35). Owens also characterizes his device as “non-sacrificial” (column 1, line 31), since the metallic substance is not consumed.

While applicant's device also comprises a container that holds a metallic substance, and while combustion of a fuel does take place in the fireplace or stove in which applicant's device is intended for use, that is where the resemblance with the Owens device ends; the fuel which is to be burned in the fireplace or stove, by contrast,

does NOT flow through applicant's container (that is, the container does not define a flow path for the fuel), and the metallic soot removal agent in applicant's device never comes into contact with the fuel (at least not in its solid or melted forms), and therefore has no effect on, and does NOT act as a catalyst in, the combustion of that fuel. Moreover, as applicant's specification makes clear, applicant's soot removal agent is "sacrificial" in that it is consumed as part of normal use during the useful life of the product; this is the antithesis of a catalyst, which by definition is not consumed or "used up" during the course of the reaction that it mediates.

Applicant has now amended the pending independent claims (claims 1, 19 and 20) to add *structural* limitations which emphasize these important distinctions, and it is therefore submitted that the Owens device no longer meets the structural limitations of those claims, and that those claims now recite structural differences that patentably distinguish the claimed invention from the prior art. In particular, the pending independent claims now recite that the soot removal agent itself is "sacrificial," and that the container is configured not only so as to prevent the flow of fuel therethrough (that is, the container does not define a flow path for the fuel), but also so as to prevent any contact between the fuel and the soot removal agent, at least while the latter is in solid or liquid (non-vaporized) form.

Applicant further submits that, based upon these amendments to independent claims 1, 19 and 20, all of the dependent claims are now allowable as well. With respect to dependent claims 3, 9, 10, 12-17 and 22, applicant submits that it would not have been obvious to one of ordinary skill in this art to utilize the Owens device in a manner, as postulated by the Examiner, which is completely contrary to its teachings. Certainly, one of ordinary skill would not have been led to utilize the Owens device in a manner in which (a) the container does NOT define a flow path for the fuel, (b) the container PREVENTS any contact between the catalytic metal substance and the fuel, and (c) the catalytic metallic substance is sacrificed (that is, heated to the point that it melts and then vaporizes), and is released from the container. Again, this is the antithesis of the function of a catalyst, which by definition is neither "used up" nor released; yet use as a catalyst is the only use for the metallic substance that is taught by Owens.

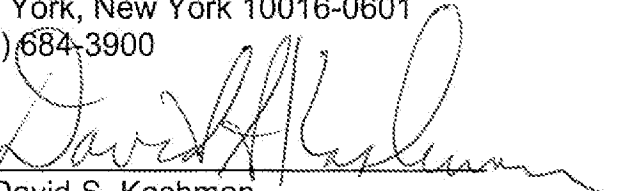
The Commissioner is requested to construe this paper as including a retroactive petition for a one-month extension of time in which to file a response to the outstanding Office Action, and accordingly, the official fee of \$65.00, as prescribed therefor by 37 C.F.R. §1.17(a)(1), as amended, in the case of a small entity, is submitted herewith.

The Commissioner is authorized to charge any additional extension fees which may be required, or to credit any overpayment, to Deposit Account No. 07-1730.

Applicant has responded herein to the points raised by the Examiner in the Office Action, and applicant has amended the claims in an earnest effort to place this application in condition for allowance. Accordingly, it is respectfully submitted that the subject application is now in condition for allowance, and further favorable action is earnestly solicited. The Examiner is invited to contact the undersigned attorney by telephone if it will advance the prosecution of this case.

Respectfully submitted,

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